



2675

RESPONSE

UNITED STATES PATENT AND TRADEMARK OFFICE

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Technology Center 2600

In re application of:

Ophira and Dov Aharonson

Serial No. 08/729,341

Art Unit: 2675

Filed: October 16, 1996

Examiner: Nguyen, Chanh Duy

For: METHOD OF AND STATION FOR INTEGRATED TYPED DATA AND
OPTICALLY SCANNED DATA CAPTURE FOR COMPUTER INTERFACING
AND THE LIKE

Commissioner for Patents
Mail Stop: Amendments
P. O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Replies to the Office communication of May 5, 2004, the Examiner has reiterated his previous position that applicants' disclosure does not support the limitation of Cotte claims 1 and 32 of

"wherein said placement alone is sufficient to initiate said drawing, and said computer comprising means for displaying, in response to said placement, a plurality of user-selectable options for processing said image data".

The Examiner also discussed the expert testimony provided in the Declaration of Ralph Rodriguez, but has not actually provided any authoritative references, citations or evidence that a single fact therein stated under oath, is incorrect.

And finally, the Examiner has completely failed to justify his thwarting of the established rules of practice governing the authority and behavior of the examining corps.

The Examiner is Erroneously
 Reading Into The Claims A
 Limitation That is Not There:
 That the "means for displaying" is
 "in response to said placement"
ONLY

The phrase of the claims in question has *two* parts.

The First Part

First,

"wherein said placement alone is sufficient to initiate said drawing".

As to this first part, as pointed out in the expert testimony of Mr. Rodriguez,

paragraph 7, applicants' specification positively teaches that in the "Master" mode,

"the scanner can be set into operation... 'simply by' (column 6, line 17, 18)
 the act of 'inserting a document into the scanner feeding slot 14'".

The words "simply by" are entirely synonymous with the claim word

"only" in this context.

That the previous Examiner fully understood this is further established by the
 allowance of claim 3, in applicants' parent patent 5,623,285:

"means at the scanner for enabling the scan automatically to start
 scanning upon insertion of the document in said document guide slot in a
 master mode".

"Automatically to start scanning upon insertion of the document" means exactly
 the same thing as the words of the Cotte claims -- "wherein said placement alone is
 sufficient to initiate said drawing".

Applicants thus fully disclose this *first* part of the claim phrase.

For the present Examiner to now take a different position is not only technically
 incorrect, but it is contrary to the clear provisions of MPEP Sec. 706.04, requiring "full
 faith and credit... be given to... the action of a previous Examiner ... (and) an Examiner
*should not take an entirely new approach or attempt to reorient the point of view of a previous
 Examiner...*".

The Second Part

Secondly,

"and said computer comprising means for displaying, in response to said placement, a plurality of user-selectable options for processing said image data".

The current Examiner has now stated that he

"agrees with declaration that the menu selection is well-known in the art to display the display screen". (page 8 of the Office action)

The Examiner also agrees that applicants' disclosure supports such a computer

and display screen (H2).

The Examiner appears not to appreciate that the original specification, in its introduction, moreover, identifies and thus incorporates by reference specific types of then current computers ("IBM PC", "Apple 105", etc.). all with their then well-known "plurality of user-selectable options" for processing scanned images as referenced and described in the Rodriguez declaration.

If the Examiner is unfamiliar with these vintages of computers referenced in applicants' specification and how they operate, expert Rodriguez has supplied sworn testimony as to the same, and not a single fact of the declaration has been disproven by the Examiner. Does the Examiner need operation books of the "IBM PC", etc.? (Applicants make proffer of the same in such event). It is believed, however, that the sworn operational testimony of their operation by expert Rodriguez should be accepted.

The specification also lists specific types of then-current scanners ("AVR 3000/65Plus; HP Scan-Set Plus; Microtek MSP-300G", etc.) for sending scanned image data for display and processing by such computers.

There is thus inherent in applicants' disclosure the well-known operation, interfaces and user selectable options of the then current computers with which the applicants' improvements were intended to operate.

There is thus no question but that applicants' disclosure fully supports

"said computer comprising means for displaying... a plurality of user-selectable options for processing said image data".

This leaves the phrase that the "means for displaying... said image data" occurs "in response to said placement".

It is believed that the Examiner has read (mis-read) this to insert the word "*only*" before "in response to said placement" --but this is actually neither a requirement of the claim, nor is actually done in the Cotte system, nor in applicants' system, nor in any computer system yet invented -- at least to applicants' knowledge.

There are two responses, not just the one response to "placement" technically required for display:

- (1) There must be, as the claim recites, "displaying" of the scanned image data, which requires a *first* or *initial* "response to said placement", or else there is no scanning done and no image data for the computer to display; but
- (2) There must be, also, a *second* response coming from the claim's further recitation of "*user-selectable options*" to effect the display.

Unless the user selects, as required by the claim, the first requirement for scanning in response to the placement, will do nothing in Cotte or in applicants' systems (or any other) to bring the image data onto the screen.

Applicants and Cotte thus meet, in the same manner, the phrase "means for displaying, in response to said placement" [--i.e. the *first* response to placement being necessary to produce the scanned image data in the first place to transfer to the computer --], and they both meet, in exactly the same manner, the "plurality of user-selected options" [--the *second* response needed (by the user, not the placement) and claimed as required by user selection --] for the ultimate processing of said image data".

The present Examiner -- with respect -- is reading the word "*only*" into this requirement for "response to said placement", which is not in the claim, and which is

not even technically correct in either Cotte or applicants' disclosure if thus mis-construed.

There is, moreover, a long - established rule of claim construction for interference purposes, that claims must be construed *as broadly as reasonably possible* --and not to be construed narrowly.

The Office statement that

"the specification of the invention does not specifically recite that the "menu" is displayed on the display screen in response to the placement"

again has nothing to do with the actual language of the claims. The claims are concerned, rather, with the scanned image data that is ultimately displayed (and which is indeed made available to the computer for display "in response to the placement") and as ultimately displayed by a second response to "user selectable options", as earlier explained.

That the prior Examiner understood this is clear from the allowance of claim 3 of the parent patent 5,623,285:

"means at the scanner for enabling the scanner *automatically to start scanning upon insertion of the document* in said document guide slot in a master mode and to initiate communication protocol with the computer so that the computer may receive the scanned data and store the same for retrieval".

**Applicants' Further Demonstration
Of Complete Disclosure To One Skilled
In This Art**

Applicants' counsel requested their Israeli clients, the applicants above-identified, to submit in their own words, their views as to the examiner's technical position, and their submission is now reproduced herein as part of this response.

"Following our phone conversation I understand that we should concentrate on the following Visioneers claims-

They claim that in response to placement of document in the scanner the scanner start immediately and automatically, with no further user operations, scanning the document and also display the scanned image on the screen. While they say "immediately and automatically" start scanning they do not say immediately and automatically on the display function.

I further understand that we should try to show that there are two separate operation here-
1. Starting immediately and automatically the scanning function and transfer of scanned data to the PC.

2. Initiating a protocol that enables the display of data on the screen, which actually explains in more details Visioneers claim for the process which allows the display of data on the PC screen.

Please let me highlight and explain all references in our application which relates to the above items-

1. On column 6 line 30 of our application-

1 modes of scanner operation:
 30 a) Master mode—the scanner automatically starts scanning, initiates communications protocol with the host computer and the host receives the scanned data into a "spool" directory where it is stored for application to retrieve it; and
 35 b) Slave mode—the host computer initiates the scanning process utilizing a system command. (SCAN lontional

According to our application: Insertion of document into scanner feeding slot in master mode will trigger automatically 3 different functions-

- A. Start scanning by the scanner.
- B. Initiates communication protocol between the PC computer and the scanner, examples for protocol details are given by the flowcharts 7a-7g.
- C. Have the PC computer start receiving data into "Spool" directory to be retrieved by application activated by the various protocols.

2. On column 8 line 1 of our application-

5,623,285
 8
 : pro- can be attained. In this mode of operation, the master device
 curity is the keyboard-scanner of the invention, and the computer
 is used as a slave output device for display communication
 tional and printing. When operating in "master" mode, the key-
 /e the 5 board-scanner device can function as three totally different
 produc- devices. It serves the computer as a regular keyboard; but
 when the user inserts a document into the document feeding

Here we clearly disclose that in "master" mode the computer is used as a slave output device and we specifically mention the following function of the PC in this mode as-

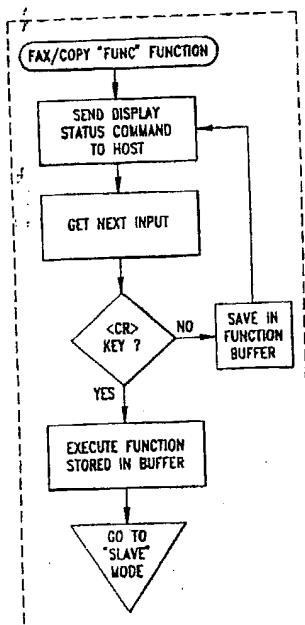
- a. Display
- b. Communication
- c. Printing.

Further more on same column 8 line 10 we add the following-

10 operation of the device from a regular keyboard (slave input device) into an independent fax or copy machine, where the keyboard-scanner is the master device and the computer is used (transparently to the user) as a slave output device.
 This operation is shown in the flow charts of FIGS.
 7A-7F, using the supplemental key controls of FIG. 6. First,
 15 the keyboard may operate in its default "slave" mode, as shown in FIGS. 7A and 7B. The user inserts a document into

When the scanner is in master mode "the computer is used (transparently to the user) as a slave output device" for the above mentioned operations of Display, Communication and Printing. We clearly state here that the PC performs its display, print and communication applications automatically (transparently to the user), the user is not required to do any operation to make these functions performed!!! THEY ARE INITIATED BY THE Master scanner mode automatically! Further more we specifically point to protocol algorithms described by 7A-7F for the details of the operations performed transparently to the user.

3. Fig 7F in our application -



We show the algorithm details of any of the functions (fax or copy) to be performed by the host/scanner. The "Display" of scanned data, which is mentioned earlier on column 8 line 3 is not mentioned here as a separate protocol because it is part of the functions embedded in each of the protocol detailed algorithm and not an independent function by itself, when each of the protocols is executed it perform status display, which displays the scanned data within the scanning loop.

According to the protocol algorithm on Fig 7F-

1. We perform an input loop where on each iteration:
 - a. Scanner "master" gets new scanning input buffer.
 - b. Saves the data into the function buffer (the function application and its buffer are on the slave host).
 - c. After each such update of the new scanned line buffer on the host function buffer it sends display status command to the slave host, the only thing the host has to display each time we send new scanned lines is the scanned lines, nothing else has been changed, we are getting scanned lines and we display the scanned lines we get. And according to previously mentioned paragraph we specifically mentioned that all these operations are being done transparently to the user, automatically.
2. When scanner "master" finishes getting all buffers of all scanned lines we exit the loop to execute the function saved in the buffers which may be fax or copy to printer or to file.

4. The use of the term "spool" directory:

On column 6 line 3 (see item# 1 above), we mention that in master mode of operations, 3 different functions are triggered in parallel:

- a. The "master" scanner starts scanning.

- b. A communication protocol is initialized between the scanner and the PC.
- c. Scanned lines are transferred by the master scanner to PC "SPOOL" to be retrieved by slave applications.

The term SPOOL is used on purpose here. It is being borrowed from well known behavior of printing application interface under Microsoft Window 3.00 -3.11 operating system which was widely used at the time of our patent application.

In case of printing interface the roles of "Master" and "Slave" are reversed comparing to our case, the host PC is the master and its application is pushing printing data line by line to the printer SPOOL, the printer is the slave application which in turn was activated and was waiting for received lines-data in the SPOOL.

There were two well known modes of operations that the user could select for SPOOL under Windows operating system:

- a. First mode the SPOOL did wait to receive all printing document data before starting to print the output to the printer.
- b. Second SPOOL mode of operation the SPOOL "automatically and immediately" did print data lines as they arrived to the SPOOL without waiting for the "master" to finish first the transfer of all document data for printing.

The use of SPOOL term implies that the slave side may get information as it is received by the SPOOL, line by line and automatically print (or display in our case) without waiting for any further operation of the user or for the completion of the hole process (printing or scanning in our case).

We have chosen specifically the SPOOL term to describe well known master/slave interfacing under the Microsoft operating system.

In our case the master is the scanner it activate the PC as a "slave output device for display communication and printing" These slave functions are waiting on the SPOOL to start DISPLAY OR COMMUNICATE OR PRINT which are the mentioned slave functions, and in accordance to the well known behavior of the Windows SPOOL operations they either wait for the hole document or they do it on the fly while each line of document is received on the SPOOL.

5. Comment on examiner response to Mr. Ralph Rodriguez regarding the issue of MENU being well known in the art:

MENU has been used as a standard user interface for almost any application running under Windows operating system (Microsof, XWindow, Mac and others, since mid 80s) All graphic user interface development tools published by Microsoft and other systems had the MENU interface built into the development tool itself, so for any application developed for any of the Windows operating system, a special effort should have done not to use a MENU interfacing, the standard was to have a MENU for user selection of application function. The only reasonable reason not to disable MENU could be if the PC used did not have a display (which is not in our case where we clearly show PC monitor in our configuration) or the application did not have any options to be selected by the user, which is in contradiction to the claim in the patent application.

I am amazed to see that the examiner managed to find another reason for not using MENU on PC application, the examiner states on his response that: "Secondly, the menu selection is not obvious or inherent for any application in the art because it requires large memory to store the function of menu which some device may not have it" (page 8 of examiner response).

To my opinion any one with minium understanding in the art, should know that in case of scanning application, the amount of memory required for MENU (which should be in the range of few hundreds of data bytes) is not an issue comparing to few hundreds of thousands to few mega-bytes required for image display and processing, so examiner "EXPLANATION" here looks odd to say the least.....

Also comparing the MENU to different PC HW configuration raises big questions to examiner understanding the difference between "make to order" PC HW configuration which may help users and manufacturers reduce PC cost and having MENU as standard user interface as a basic requirement from any Windows based application standard."

Conclusion

The Examiner has stated that if the previous Examiner found "no 112 to all the limitations of the copied claims...then the present Examiner will withdraw his 112 ground rejection." (Page 6)

It is believed that applicants have above shown that in allowing similar language claims in the parent patent, the previous Examiner found adequate disclosure.

Our office records show at least seventeen (17) telephone discussions and messages with the previous Examiner in the period from the October 16, 1996 request for an interference, through the March, 1999 suspending of Ex Parte prosecution for the re-examination of the Cotte patent, to the May, 2000 termination of the re-examination and then to the turning over of this application to the present Examiner in or about

September of 2001.

In not a single one of these discussions did the previous Examiner question any 112 support for these claims, or talk of any action he was intending to propose other than the declaration of an interference.

If the previous Examiner had held the present Examiner's 112 views, there would have been no need to suspend Ex Parte prosecution until determination of the re-examination — only to reject the claims as not supported by the disclosure.

Clearly, in continuing all these years and entering the suspension, the view of the previous Examiner, as conveyed to us, was that an interference was appropriate.

Never, in response to applicants' status requests, or oral and written communications with the first Examiner, over a *six-year period*, did the first Examiner ever raise any issue, 112 or otherwise, of the adequacy of applicants' specification to support a single one of these claims—only the continuing promise of the declaration of an interference "soon".

As earlier pointed out--and the present Examiner has *not* answered this--MPEP-Sec. 2307.04. --specifically restricts the use of such a suspension to cases "*otherwise in condition for allowance*".

The first Examiner thus clearly issued the suspension under this understanding of allowability to applicants; and applicants had no objection, being also anxious to determine the validity of the claims under re-examination.

As also earlier pointed out--and again the present Examiner has *not* answered this--the MPEP instructs the Examiner to continue the prosecution "as far as possible", being specifically *mandated* by MPEP Sec. 707.07/g to "*reject each claim on all valid grounds available*".

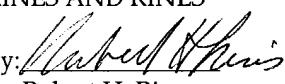
The first Examiner had no such grounds (certainly not § 112) and did not assert any.

As also earlier pointed out--and again the present Examiner has *not* answered this--the MPEP Sec. 706.04 --requires "*full faith and credit...be given to...the action of a previous examiner... (and) an examiner should not take an entirely new approach or attempt to reorient the point of view of a previous examiner...*"

Withdrawal of this improper and greatly belated § 112 rejection, and the prompt declaration of an interference are therefore respectfully requested--particularly, as has been shown, in light of the technical incorrectness of the new § 112 rejection.

Any costs incurred by this amendment, including for any required time extensions, petition for which is hereby made, may be charged to Deposit Account No. 18-1425 of the undersigned attorneys.

Respectfully submitted,

RINES AND RINES
By: 
Robert H. Rines
Registration No. 15,932

Date: November 4, 2004
RINES AND RINES
81 North State Street
Concord, NH 03301
Tel: (603) 228-0121



CERTIFICATE OF SERVICE

I, the undersigned, hereby certify that I caused to be mailed by the United States Express Mail Service, No. EV 450812351 US, under date of November 4, 2004 postage pre-paid, a response in US 08/729,341

Inventors: Dov and Ophira Aharonson

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Technology Center 2600

Irene O'Mara

Irene O'Mara

Date: November 4, 2004